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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,182	07/06/2001	Jean-Louis H. Gueret	5725.0701	9798

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
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HUYNH, KHOA D

ART UNIT	PAPER NUMBER
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3751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/899,182

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Khoa D. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-335 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-83, 296-301, 308-313 and 320-325 is/are allowed.
- 6) ☒ Claim(s) 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 85-87,90-124,128-130,133-167,171-198,204-230,234-261,267-293,302-307,314-319 and 326-331.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the back face of the at least one notch is defined by bristles having varying lengths as recited in claims 84 and 127 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 84 and 127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims 84 and 127 recite the limitation "the back face of the at least one notch is defined by bristles having varying lengths". However, such claimed subject matter was not described in the original specification. In the original instant disclosure, applicant discloses (col. 3, lines 6-11) that the bristles of the brushes may be of any type: bristles with different heights, different diameters or cross-sections and made of different materials. Nevertheless, the original disclosure does not disclose that the back face of the at least one notch is defined by bristles having varying lengths. Therefore, claims 84 and 127 contain subject matter that constitutes new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 84, 88, 89, 125-127, 131, 132, 168 and 169 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Both claims 84 and 127 recite the limitations "the back face of the at least one notch is defined by bristles having varying lengths". However, such recitations render the claims indefinite because the claimed subject matter does not have any support in the instant specification. Since the claims do not clearly set forth the metes and bounds of the patent protection desired, the scope of the claims is unascertainable. Claims 88, 89, 125, 126, 131, 132, 168 and 169 depend on claims 84 and 127 and are likewise indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery (4403624).

Regarding claim 84, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one

notch intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 88 and 89, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 125 and 126, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 127, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles define an external surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein the trough line extends in a direction non-perpendicular to the length of the elongate core,

wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 131 and 132, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 168 and 169, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 170, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the



back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 199 and 200, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 201, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 202 and 203, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 231 and 232, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 233, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 262 and 263, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 264, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 265 and 266, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 294 and 295, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

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Each of claims 332-335 recites limitations that are substantially similar to the limitations of claims 84, 127, 170, 201, 233 and 264 which have been rejected as discussed supra.

***Allowable Subject Matter***

8. Claims 1-29 (previously allowed claims), 30-83, 296-301, 308-313 and 320-325 (newly added dependent claims that depend on claims 1-29) are allowed over the prior art of record.

***Response to Amendment***

9. Applicant's amendment, filed on 11/14/06, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

***Response to Arguments***

10. Applicant's arguments filed on 11/14/06 with respect to the pending claims have been fully considered. However, such arguments are deemed not persuasive.

Regarding the drawings objection and 112, first paragraph, rejection, applicant, in the arguments, indicates that the embodiment of Fig. 1A and the specification, column 4, lines 6-9, disclose "the back face of the at least one notch is defined by bristles having varying lengths" as recited in claims 84 and 127. Nevertheless, after full reviewed of the instant specification, especially column 4, lines 6-9 and Fig. 1A, it is noted that such claimed subject matter was not described in the original specification. In other words, the original disclosure does not disclose that the back face of the at

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least one notch is defined by bristles having varying lengths. Therefore, claims 84 and 127 contain subject matter that constitutes new matter.

Applicant also asserts that the Montgomery reference does not teach the features as claimed in the independent claims. See remarks section, pages 63-64. The examiner disagrees. As stated in the above rejection, the Montgomery reference does teach a brush having an elongate core and bristles extending from the core, two notches formed on the external surface of the brush, wherein each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line, wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch. Since the Montgomery reference does disclose each of the claimed features, Montgomery does suggest applicant's invention as claimed.

Applicant also asserts that the gap between elements 66" of Montgomery is not on an external surface of the brush. The examiner disagrees. As shown in Figure 13 of Montgomery, the notch (constitute by the gap between the bristles as shown in Fig. 13) does form on the external surface of the brush. Accordingly, the Montgomery gap does correspond to the recited "notch".

Since Montgomery does teach a brush having all features as claimed in the independent and dependent claims, the rejection based on Montgomery is proper.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoa D. Huynh  
Primary Examiner  
Art Unit 3751

HK  
02/05/07